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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/351,747	07/08/1999	RICHARD PRESCOTT SKILLEN	HQ0045A	1165

7590 02/28/2005  
GARLICK & ASSOCIATES  
P O BOX 0691  
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EXAMINER

JUNG, DAVID YIUK

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/351,747

Applicant(s)

SKILLEN ET AL.

Examiner

David Y Jung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/13/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19, 75-79, 107 and 108 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19, 75-79, 107 and 108 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### CLAIMS PRESENTED

Claims 1-6, 9, 11-19, 75-79 and 107-108 are present in the application.

### RESPONSE TO ARGUMENTS

The Appeal Brief has been carefully studied. Yet, the issue regarding Sullivan reference is still not convincing. The Appeal Brief gave arguments regarding Sullivan. The arguments can be summarized as stating that the "selling of keywords" of Sullivan do not correspond to the "correlating the search argument to particular advertisement."

The Office has already presented the issue in a previous Office Action. The following sentences directly repeat the statement from the Sullivan was referring to the state of search engines. Search engines (then and now) were particularly used for such handling of advertisements. See, for instance, [www.google.com](http://www.google.com) 's <https://adwords.google.com/select/advantages.html> (attached to this Office Action). This website is not given as prior art; rather, the website is given to illustrate a typical use of search engine (then and now). This gives a typical use of search engines (then and now): keywords of search arguments are used to correlate to the advertisement. Thus, cited passages of Sullivan (as Sullivan directly mentions search engines in such fashion) would teach such "correlating the search argument to particular advertisement" of the claimed invention. Yet, aside from merely stating so, Applicant still has not shown how such ordering of the advertisements would not necessarily teach the correlation of the advertisement.

While the previous rejections may have been correct, in hopes for clearer explanation to Applicant, [www.google.com](http://www.google.com) example is further illustrated using two new references explaining [www.google.com](http://www.google.com). In view of the Appeal Brief filed, PROSECUTION IS HEREBY REOPENED as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

## **CLAIM REJECTIONS**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The texts of the rejections in the previous Office Actions are referred in this present action. The texts of those rejections can, of course, be found in the previous Office Actions, such as that Office Action dated 6/11/2003.

Claims 1-6, 9, 11-19, 75-79 and 107-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pointcast and Sullivan (as noted in the Office Action dated 6/11/2003) and Brin ([http://en.wikipedia.org/wiki/Sergey\\_Brin](http://en.wikipedia.org/wiki/Sergey_Brin)) and Google ([http://en.wikipedia.org/wiki/Google\\_Inc](http://en.wikipedia.org/wiki/Google_Inc).)

In regard to claim 1, Pointcast teaches "a method of providing advertisements to a user searching for desired information within a data network, comprising the steps of:

receiving, from the user, a search request including a search argument corresponding to the desired information (page 9, table 1, selections);

searching, based upon the received search argument, a first database having data network related information to generate search results (page 9, table 1, selections);

... a particular advertisement in a second database having advertisement ... (page 12, table 2, database update, advertisement); and

providing the search results together with the particular advertisement (page 13, table 2, server sends requested items to client) ...."

These passages of Pointcast are not explicit about providing the results "to the user."

It is well known in the art to provide results (such as that sent from server to the client) to the user for the motivation of user access. It would have been obvious at the time of the claimed invention to modify Pointcast to provide results "to the user" as in claim 1 for the motivation noted above.

These passages of Pointcast are not explicit about "correlating the received search argument to ... related information."

Sullivan teaches "correlating the received search argument to ... related information (i.e. Open Text sells keywords .. You can have your site appear in the top listing) for the motivation of commercial profit (i.e. "for \$2000 and up").

It would have been obvious at the time of the claimed invention to combine Pointcast and Sullivan to have "correlating the received search argument to ... related information" as in claim 1 for the motivation noted above.

Applicant appears to dispute that this "correlating" is related to "database."

Brin (the reference that discusses Mr. Sergey Brin) teaches that such "correlating" to be related to "database" (section "Interest in Search engines", i.e. data-mining and pattern extraction) for the motivation of ease of handling the Internet. Data mining and pattern extraction necessarily involve "correlating" to at least one "database." Brin teaches that such activities of Mr. Sergey Brin occurred before Mr. Sergey Brin met Mr. Larry Page.

Google (the reference that discusses Google company) dates the meeting as that of 1996 (section, Beginnings). Google teaches that the search engine with such "correlating" with "database" (i.e. based on analysis of the relationships between data in Web sites) occurred in 1996 for the motivation of "producing better results than the basic techniques then in use (section, Beginnings)."

It would have been obvious at the time of the claimed invention to combine the teachings of Pointcast and the teachings of Sullivan and the teachings of Brin and the teachings of Google to have "correlating" with "database" as in claim 1 for the motivations noted in the previous paragraphs.

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Regarding claims 2-19, 29-79, 86-113, as detailed in the previous rejections, such features of these claimed inventions are well known in the art for the motivation of finding data for electronic commerce. For example, the anecdotal enhancements of claim 106 are well known for the motivation of enhancing electronic commerce. As another example, the search engine of claim 94 is well known for the motivation of finding data for electronic commerce.

### ***Conclusion***

The art made of record and not relied upon is considered pertinent to applicant's disclosure. The art disclosed general background.

### ***Points of Contact***

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 746-7239, (for formal communications intended for entry)

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Or:

(703) 746-5606 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

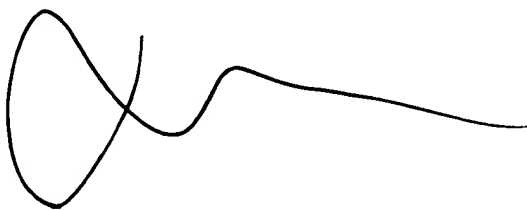
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Jung whose telephone number is (571) 272-3836 or Greg Morse whose telephone number is (571) 272-3838.

David Jung

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Patent Examiner

2/20/05

A handwritten signature in black ink, consisting of a large loop followed by a series of connected, slightly wavy lines extending to the right.